

REMARKS

By this Amendment, Applicant has amended claims 1-6, 11, 15, 17, 23, 25-26, 31-41, 46, 50, 51, 52, 58, 60-61, 66-76, 81, 85, 86, 87, 93, 95-96, and 101-105 and added new claims 106-111. Claims 1-111 are pending. Support for these amendments are found for example at ¶¶ 57 and 63 of Applicant's specification.

In the outstanding Office Action dated December 14, 2004, the Examiner rejected claims 1-23, 25-58, 60-93, and 95-105 under 35 U.S.C. § 102(b) as being anticipated by Gardenswartz et al. (U.S. Patent No. 6,055,573); and rejected claims 24, 59, and 94 under 35 U.S.C. § 103(a) as being unpatentable over Gardenswartz et al. Applicant respectfully traverses these rejections for the reasons below.

I. **The Rejections of Claims 1-23, 25-58, 60-93, and 95-105 Under 35 U.S.C. § 102.**

As noted above, Applicant respectfully disagrees with the Examiner's rejection of claims 1-23, 25-28, 60-93, and 95-105 under 35 U.S.C. § 102(b) as being anticipated by Gardenswartz et al.

To support a rejection under 35 U.S.C. § 102(b), the single prior art reference must disclose either expressly or inherently, each and every element as set forth in the claims. M.P.E.P. § 2131.

Here Gardenswartz et al. fails to teach each and every recitation of claim 1. In particular, claim 1 recites "a method for providing a purchase transaction incentive" including, *inter alia*, "determining whether the first consumer corresponds to a geographic zone that is associated with the purchase transaction incentive," and

“providing, when it is determined that the first consumer corresponds to the geographic zone, the purchase transaction incentive based on ... stored data relating to transaction and ... stored identification data relating to identification code.”

Gardenswartz et al., in contrast, discloses a method and system for delivering advertisements based on only the “offline purchase histories of consumers.” (Col. 10, lines 3-5.) To this end, the analysis unit 16 analyzes a list of customer identifications to classify each consumer “into one or more purchase behavior classifications based on purchase behavior criteria.” (Col. 13, lines 1-4.) For example, the criterion for a class of “heavy Brand Z drinkers” may be consumers who purchased Brand Z at least twice a year. (Col. 12, lines 35-49.) After classifying the consumers, analysis unit 16 then sends targeted ad profiles for each consumer based on each consumer’s classification. (Col. 13, lines 5-7.)

Gardenswartz et al. does not disclose or suggest, however, “determining whether the first consumer corresponds to a geographic zone that is associated with the purchase transaction incentive,” and “providing, when it is determined that the first consumer corresponds to the geographic zone, the purchase transaction incentive ...,” as recited in claim 1. Indeed, Gardenswartz et al. is entirely silent with regards to determining whether a first consumer “corresponds to a geographic zone” as part of providing any targeted advertisement to that consumer. Gardenswartz et al., therefore, fails to disclose each and every element of claim 1. Applicant, therefore, respectfully requests the Examiner to withdraw the rejection and allow the claim.

Claims 36 and 71, although of different scope, recite elements similar to that discussed above with regard to claim 1. Applicant therefore requests the Examiner to

withdraw the rejection of claims 7 and 13 for at least the same reasons discussed above for claim 1.

Claims 2-23 and 25-35, 37-58 and 60-70, and 72-93 and 95-105 depend from claims 1, 36, and 71, respectively. As explained, claims 1, 36, and 71 recite elements not disclosed or suggested by Gardenswartz et al. Accordingly, claims 2-23, 25-35, 37-58, 60-70, 72-93, and 95-105 are allowable over Gardenswartz et al. for at least the same reasons as claims 1, 36, and 71. Applicant therefore respectfully requests that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Furthermore, Applicant notes that many of the claims dependent from claims 1, 36, or 71 are directed to additional subject matter that is totally remote from the teachings of Gardenswartz et al. For example, claim 7 recites “determining attributes of a first group of consumers in the market population who have purchased the item,” “determining attributes of a second group of consumers in the market population who have not purchased the item,” and “determining differences between the first group of consumers and the second group of consumers to identify attributes of consumers exhibiting a desired buying behavior.” In the Office Action, the Examiner alleges that Col. 15, lines 19-40 of Gardenswartz et al. teaches these limitations. Applicant disagrees. The cited passage of Gardenswartz et al. merely discloses a way to implement a “value contract.” In particular, the Examiner refers to step 1000 of Fig. 10, which describes how the analysis unit 16 searches the purchase history database for eligible consumers based on factors including “the purpose of the contract, whether the consumer’s observed offline purchase history meets certain criteria, and the consumer’s

response to previously delivered target advertisements including value contracts.” (Col. 15, lines 23-28.)

The above portions of Gardenswartz et al., however, utterly fail to disclose or suggest “determining differences between the first group of consumers and the second group of consumers to identify attributes of consumers exhibiting a desired buying behavior,” as recited in claim 7. Claims 42 and 77, although of different scope, recite elements similar to those discussed above of claim 7. Therefore, Applicant submits that claims 7, 42, and 77 are allowable for at least these additional reasons.

Gardenswartz et al. also fails to teach all of the elements of claim 12. For these claims, the Examiner relies on Col. 16, lines, 15-35, Col. 18 lines 6-30, and Col. 9, lines 1-15 of Gardenswartz et al. At most, the cited passages simply disclose ranking a consumer. For instance, the reference describes including a “rank (e.g., ‘50th out of 50,000) that the consumer has received based on selected purchase behavior criteria.” (Col. 9, lines 7-15.) This disclosure of ranking a consumer, however, does not equate to any disclosure or suggestion of “ranking each marketing channel based on the success of the purchase transaction incentive as provided through that marketing channel,” as recited in claim 12. The same applies to claims 47 and 82, which, although of different scope, recite elements similar to those of claim 12. Therefore, Applicant submits that claims 12, 47, and 82 are allowable for at least these additional reasons.

Gardenswartz et al. further fails to teach all the elements of claim 26. Here, the Examiner relies on the disclosure at Col. 20, lines 9-25, which describes that the reward received by the consumer may include “points that accumulate and can be redeemed for a prize” and rewards that “can be delivered as coupons appearing on a personalized

Web page, Internet banner, e-mail, regular mail etc.” While this portion of Gardenswartz et al. describes various kinds of rewards, it does not disclose or suggest “determining whether the consumer is eligible for an instant purchase transaction,” as recited in claim 26. Claims 61 and 96, although of different scope, recite similar elements. Therefore, Applicant submits that claims 26, 61, and 96 are allowable for at least these additional reasons.

II. The Rejections of Claims 25, 59, and 94 Under 35 U.S.C. § 103.

Claims 24, 59, and 94 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardenswartz et al. Claims 24, 59, and 94 depend from claims 1, 36, and 71, respectively. As explained, claims 1, 36, and 71 recite elements not disclosed or suggested by Gardenswartz et al. Accordingly, 24, 59, and 94 are allowable over Gardenswartz et al. for at least the same reasons given above with respect to claims 1, 36, and 71. Applicant, therefore, respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

III. New Claims 106-111.

New claims 106 and 107 recite “wherein providing a purchase transaction incentive further includes providing a coupon with a monthly credit card statement” and “inserting the purchase transaction incentive into a credit card statement.” Gardenswartz et al. also fails to teach these limitations. More specifically, Gardenswartz et al. simply discloses that the targeted advertisements may include

“Internet banners, real time moving videos, video information, animation information, audio information, online interstitial advertisements, electronic mailings (e-mails), interactive television advertisements, and any other type.” (Col. 7, lines 20-24.)

Gardenswartz et al. does not disclose or suggest, however, providing a coupon with a monthly credit card statement or inserting a purchase incentive into a credit card statement, as recited in claims 106 and 107, in addition to the limitations of independent claim 1. Claims 108-111, although of different scope, recite similar elements. Therefore, Applicant requests the Examiner to allow claims 106-111 for at least these reasons.

IV. Conclusion

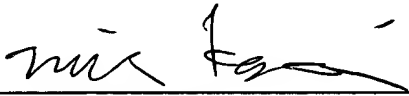
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 14, 2005

By: 
Milan Kapadia

Reg. No. 55,982